

REMARKS

Claims 1, 2, 4, 8-11 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Vaisanen et al.* (US006560443B1) in view of *Rabe et al.* (US006138010A). Also, claims 3, 5-7, 12-15, and 19-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Vaisanen* and *Rabe* in view of *Dvorkin et al.* (US006249686B1). Applicants traverse these rejections on the grounds that the cited references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

Amended independent claims 1 now includes:

"a switch capable of differentiating communication signals and prioritized choosing of an appropriate transceiver from the set of transceivers to communicate for the computing system, transceiver preference being set through software interfaced, by the computing system's operating system, with the switch;"

Amended independent claim 14 now includes:

"prioritized selecting of a transceiver board capable of processing the received signal, the selecting being performed by a software driver instructed by

a higher level protocol stack through software being interfaced, by the portable computer system's operating system, with a switch;"

Amended independent claim 15 now includes:

"prioritized selecting of a transceiver board capable of processing the received signal, the selecting being set through software interfaced, by the portable computer system's operating system, with a switch;"

It is respectfully submitted that the examiner cannot factually support a *prima facie* case of obviousness for the following mutually exclusive reasons.

1. Even when combined, the references do not teach the claimed subject matter

Vaisanen and *Rabe* patents cannot be applied to reject claim 1 under 35 U.S.C. §103, which provides that:

A patent may not be obtained ... if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains... (Emphasis added).

Thus, when evaluating a claim to determine whether it is obvious, all limitations of the claim must be evaluated. However, the combination of the references cited by the examiner does not teach or suggest setting transceiver preference through "software interfaced, by the computer system's operating system, with the switch" as recited in amended independent claim 1.

Accordingly, because the combination of the *Vaisanen* and *Rabe* patents does not teach all of the elements of amended independent claim 1, rejection of claim 1 under obviousness is improper. Similarly, because no combination of the *Vaisanen*, *Rabe*, and *Dvorkin* patents teaches “software interfaced, by a computer system’s operating system, with a switch” as also recited in amended independent claims 14 and 15, rejections of claims 14 and 15 under obviousness are likewise improper. Dependent claims 2-13, 17, and 19-21 depend from and further limit the allowable subject matter claimed in the independent claims, and therefore are allowable as well.

2. The combinations of the references are improper

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO “failed to establish a *prima facie* case of obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant’s disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had “reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the

claimed invention [to have been] obvious.” The court noted that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.” The court further noted that there were three possible sources for such motivation, namely “(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art.” Here, according to the court, the board had relied simply upon “the high level of skill in the art to provide the necessary motivation,” without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: “If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.”

Accordingly, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejections because none of the *Vaisanen*, *Rabe*, or *Dvorkin* patents teaches or even suggests the desirability of the combinations cited by the examiner. Moreover, none of the patents provides any incentive or motivation supporting the desirability of such combinations

The MPEP provides in §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).


Therefore, the examiner’s combinations arise solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in any of the references for the combinations.

Thus, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met. Accordingly, it is respectfully submitted that independent claims 1, 14, and 15 and their dependent claims are allowable.

Conclusion

In view of the above, it is respectfully submitted that claims 1-15, 17 and 19-21 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,


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